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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,371	12/08/1999	HEINRICH BOLLMANN	12010	6395
28484	7590	01/28/2008	EXAMINER	
BASF AKTIENGESELLSCHAFT			CHANG, VICTOR S	
CARL-BOSCH STRASSE 38, 67056 LUDWIGSHAFEN				
LUDWIGSHAFEN, 69056			ART UNIT	PAPER NUMBER
GERMANY			1794	
			NOTIFICATION DATE	DELIVERY MODE
			01/28/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lori.hass@basf.com  
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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/456,371	BOLLMANN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Victor S. Chang	1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 January 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 19,20,22,23 and 30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 19,20,22,23 and 30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Introduction***

1. Applicants' amendments and remarks filed on 1/2/2008 have been entered. Claims 19, 20, 22, 23 and 30 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to applicants' arguments during an interview on 11/14/2007, the application has been carefully reviewed. In view of applicants' interpretation that the terms "rigid" and "flexible" in independent claim 19 (amended 2/23/2006) are structural features, rather than inherently properties of composition, they appear to be new matter as set forth below, the prior art references of record are withdrawn, and to be reinstated after the new matter issues are resolved, if appropriate. The grounds of rejections are updated as set forth below.

### ***Claim Rejections - 35 USC § 112***

4. The amended specification and drawings (filed 11/17/2003), and claim 23 (added 9/7/2001) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, in the 11/14/2007 interview, applicants argue that the support for claim 23 is found in the amended specification and drawings in an amendment filed 11/17/2003, which

was entered in an Office action mailed 1/7/2004. However, upon a careful review, since the amended specification and drawings filed 11/17/2003 lack a clear support in the original specification for the limitation “elastomer layer is bonded to an outer surface of said molding”, as evidenced by the fact that the structural relationship recited in claim 23 [see Office action mailed 9/28/2005, page 3] are not *directly* supported by the original specification, the amended specification and drawings filed 11/17/2003, as well as the claim 23 added 9/7/2001 are all deemed to be new matter. Applicants must provide a clear evidentiary support that the inventors had possession of the claimed invention, at the time the application was filed, in the next reply.

5. Claims 19, 20, 22, 23 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, in response to applicants argument at Remarks page 9 that

“Applicants have directed the Examiner to Figure 6 of Renzo that illustrates the thermoplastic bellow 50 as being flexible and moved between a compressed and an uncompressed state, thus not rigid.”

The terms “rigid” and “flexible” are now interpreted as structural features, rather than inherently properties of composition. However, since throughout the original specification, nowhere can a support be found for these structural features, therefore they are deemed to be new matter.

Applicants are requested to provide a clear support in the next reply.

6. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More particularly, the limitation “elastomer layer is bonded to an outer surface of said molding” in claim 23 is vague and indefinite, because the original specification lacks any disclosure of a workable embodiment having the structural relationship which can be reasonably interpreted as a support for the claimed limitation, therefore it is unclear what is the scope and/or structural definition of the term “outer surface” in a workable vehicle damping element.

***Response to Argument***

7. Applicants argue at Remarks page 5-6 that

“Figures 1-3 illustrate well known motor vehicle composite damping elements that, in accordance with the subject invention, are formed from the flexible microcellular elastomer layer being bonded to and in direct contact with at least one surface of the rigid thermoplastic polyurethane molding.”

However, Figs. 1-3 contains structures which are absent from the original specification, as evidenced by the fact that the structural relationship recited in claim 23 [see Office action mailed 9/28/2005, page 3] are not directly supported by the original specification. The examiner maintains that there is no evidence whatsoever that, at the time the application was filed, applicants had possession of the claimed structural elements. Further, even if Figs. 1-3 are to be considered, applicants have yet to provide evidences that these are workable embodiments of vehicle damping devices meeting the same performance requirements as rubber/metal devices for use as replacement vehicle damping devices [see specification page 1, lines 41-42].

Furthermore, applicants' statement appears to be admitting that the claimed invention is well known, please clarify the intention of the statement in the next reply.

Applicants argue at page 6 that

"it is inconsistent examination that the Examiner has only rejected claim 23. If claim 22 has adequate support in the specification, including Figures 1-3, then claim 23 must also be adequately supported, thereby making the Examiner rejections of claims 23 improper."

However, while a structural support for claim 22 is found in specification page 10, lines 30-31, throughout the original specification nowhere can a structural support for claim 23 (added 9/7/2001) be found.

Applicants argue at pages 6-7 that

"Those of ordinary skill in the art, upon reading the subject application, specifically, page 9, lines 4-9, in view of "Fahrwerktechnik: Radaufhangungen", 2<sup>nd</sup> Edition, ed. Prof. Dipl.-Ing. Jornsen Reimpell, Vogel Buchverlag Wurzburg, which is discussed on page 1, lines 23-26, of the specification as originally filed, would find adequate support for the structural element "elastomer layer is bonded to an outer surface of said molding" of claim 23. Thus, it is appreciated that those of ordinary skill in the art recognize that the necessary structure, or configuration, to replace any such prior art rubber-metal composites is inherent in the composite damping element of the subject invention."

However, applicants have failed to point out any embodiment in the abovementioned reference as an evidence that a workable replacement (meeting the performance requirements) for a vehicle damping device having the structure can be reasonably manufactured with significantly different and weaker materials (rubber/metal vs. PU foam/TPU) of the claimed invention. While the reference provides known structures of rubber/metal components, there is no evidence or reason whatsoever to believe that one of ordinary skill in the art would recognize that all the structural embodiments in the reference can inherently be made with significantly different

materials as workable replacements meeting the same stringent performance requirements (durability and mechanical strength, etc.) of vehicle damping devices.

Applicants argue at page 7 that

“the specification as originally filed has implicit support for any orientation, including the elastomer layer bonded to an outer or an inner surface of the molding.”

However, since there is no evidence or reason whatsoever to believe that one of ordinary skill in the art would recognize that all the structural embodiments in the reference can inherently be made with significantly different and weaker materials to produce workable replacements, it is unseen how there is an implicit support for “any orientation” would be useful.

Finally, regarding applicants’ arguments directed to the prior references of Renzo and Zeitler et al., since these references of record are withdrawn, applicants’ arguments are moot.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/  
Primary Examiner, Art Unit 1794